

## REMARKS/ARGUMENTS

The rejections presented in the Office Action dated October 6 2006 (hereinafter Office Action) have been considered. Claims 1, 2, 4-7, 10-32 and 34-40 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1, 2, 4-7, 10-32 and 34-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,950,173 to Perkowski (hereinafter "*Perkowski*") in view of U.S. Patent No. 6,122,520 to Want et al. (hereinafter "*Want*"). The Applicants respectfully traverse the rejections.

According to MPEP §2142, to establish a prima facie case of obviousness under 35 U.S.C. §103:

- 1) there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference (or references when combined) must teach or suggest all the claim limitations.

All three criteria must be met to establish prima facie obviousness of a claim. The Applicant respectfully submits that the combination of *Perkowski* in view of *Want* does not teach or suggest all of the limitations of Claims 1, 2, 4-7, 10-32 and 34-40. Furthermore, there is no suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine *Perkowski* with *Want* as suggested in the Office Action.

Claims 1, 2, 4-7, 10-32 and 34-40 at least set forth that the information pertaining to assets is entered into an asset tracking datastore by different supplier entities that handle the asset item during the item's processing through the supply chain. For example, Claim 1 sets forth that the information pertaining to a particular instance of an asset is recorded in an

independent datastore by an upstream supplier entity. Additional information pertaining to the particular instance of the asset is recorded in the independent datastore by a downstream supplier entity. This information is associated with a URL (URL) that is attached to and unique to the particular instance of the asset. The remaining independent claims also set forth some manner of recording data pertaining to the individual instances of assets of a supply chain by respective supplier entities within a supply chain, and associating with the data a URL unique to the particular instances.

In the previous Office Action Response dated August 2006, Applicants submitted that *Perkowski* failed to teach or suggest this inputting of data into a single datastore by different supplier entities. In the present Office Action, the Examiner does not concur, citing column 17, lines 26-29 of *Perkowski*, which reads “[t]ypically, each Client System 13 will be maintained by either present 115 or future manufacturers, retailers and/or consumers of products, about which information can be found on the Internet.” However, one skilled in the art would not consider these client systems 13 of *Perkowski* to be a single datastore that is accessed by different supplier entities for entering data related to supply chain assets.

According to *Perkowski*, these client systems are “a plurality of User (or Client) Computers, each indicated by reference numeral 13, being connected to the Internet via the Internet infrastructure and available to consumers” (*Perkowski*, col. 11, lines 64-67). These client computers 13 are used, for example, for receiving “documents and messages” related to “manufacturers and products” registered with the system (*Perkowski*, col. 12, lines 9-11). *Perkowski* does not teach or suggest that the client computers 13 are used for inputting data into a datastore, and in particular fails to teach or suggest the client computers are used by two or more supply chain entities entering data into the same database for an item that is handled by the respective supplier entities. As Applicants have previously argued, *Perkowski* describes a number of independently maintained information systems, but nowhere does *Perkowski* teach or suggest two or more supplier entities entering data related to assets handled by the supplier in a single database. (see Office Action Response dated August 2006, p. 18, line 12 to p. 19, line 6).

In addition to the above deficiencies, *Perkowski* is further deficient in teaching or suggesting entering data regarding particular instances of assets by the supply chain entities that process the particular instance of the asset. *Perkowski* is also deficient in teaching or suggesting accessing database information pertaining to the particular instance of the asset using a URL that is attached to and unique to the particular instance of the asset. The Examiner relies on *Perkowski* to teach these aspects of the claims, because, as stated in the Office Action “*Perkowski* shows all of the limitations of the claims except for specifying attaching to a particular instance of an asset a URL that is unique to the particular instance of the asset.” (Office Action, p. 2, lines 12-14). The Examiner further states that *Perkowski*’s system “includes Internet information servers which store information pertaining to Universal Product Number (e.g., UPC number, optically scannable).” (Office Action, p. 2, lines 18-20) However, as Applicants have previously argued, a UPC is not unique to a particular instance of an asset, but is the same for all assets of a particular product type. As a result, *Perkowski* does not teach or suggest entering data related to a particular instance of an asset, because any data entered pertaining to a UPC is the same for all instances of that product type. Further, the UPC described in *Perkowski* is not a URL, and nowhere does *Perkowski* describe using a URL that is attached to and unique to an object for accessing data about that object.

The Office Action recognizes that *Perkowski* is silent as to “attaching to a particular instance of an asset a URL that is unique to the particular instance of the asset.” (Office Action, p. 2, lines 12-14). Nonetheless, the Examiner introduces *Want* to teach this aspect of the Applicants’ claims. The Applicants submit that *Want* fails to teach or suggest “attaching to a particular instance of an asset a URL that is unique to the particular instance of the asset,” particularly when the claims and prior art are viewed as a whole, and the Applicants respectfully contests the application of *Want* to the claims of the pending application.

As unequivocally stated and described in *Want*, *Want* is directed to “obtaining location specific information about a particular location using a distributed network in combination with the positioning system.” (*Want*, col 1, lines 11-3). *Want* describes “using

bar code labels to obtain location information” by placing “a bar code label 212 ... on or in a building 210 or other location of interest...the bar code label 212 encodes either the same longitudinal and latitudinal information that would be obtained from the GPS system or may directly encode a unique URL.” (*Want*, col. 6, lines 32-42). As will be described more fully below, this is unrelated to the present invention and for various reasons significantly contributes to the failure of *prima facie* obviousness based on the cited combination of references.

During examination, an examiner is entitled to give the broadest “reasonable” interpretation of the claims (*M.P.E.P.* §2111). This interpretation must, among other things, be reasonable, consistent with the specification, and recognizable as the meaning to a person of ordinary skill “in the art in question at the time of the invention.” (*M.P.E.P.* §§ 2111, 2111.01). In the present case, the Examiner has equated “a building or other location of interest” with the well-known concept of a supply chain asset. It is respectfully submitted that this correlation is misplaced. It is known to those skilled in the arts that common terms are given special meaning in such technological areas. However, given that *Want* is related to obtaining location information and not asset tracking, the Applicant respectfully submit that the application of *Want* to Claims 1, 2, 4-7, 10-32 and 34-40, while possibly the broadest interpretation, is not the broadest “reasonable” interpretation, and is not “consistent with the specification.” See, e.g., *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

“The broadest reasonable interpretation of the claims must be consistent with the interpretation that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). “Not only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time--a technician without our knowledge of the solution.” *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985).

The Applicants respectfully submit that those skilled in the art would not interpret *Want*’s location codes as a unique identifier associated with information entered by supplier

entities regarding an asset as the asset moves through a supply chain, as described in Applicants' Specification and set forth in the Claims. For at least this reason, the Applicant respectfully submits that the consequent citing of *Want* is not commensurate with the broadest "reasonable" interpretation of these claims.

In addition to having to show that the asserted combination of references teaches or suggests all of the claim limitations, the Examiner must also show evidence of motivation to combine these references as asserted. Applicants respectfully submit that this requirement has not been met.

The requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. In the Office Action, the proffered motivation to combine the references is to "access information, in a very convenient manner, on the asset as shown by the laptop computer." (Office Action, page 3, lines 17-19). This is not evidence of motivation to combine the location markers of *Want* with the teachings of *Perkowski*, but rather, is a generalized statement of what is asserted as being taught by *Want*. No evidence has been provided in support of the proposed combination - that a skilled artisan would have attempted to introduce *Want*'s bar codes to the teachings of *Perkowski*.

The examiner must show some objective teaching leading to the asserted combination. In *re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Since neither *Perkowski* nor *Want* teach or suggest systems that track individual instances of assets in a supply chain, as discussed above, it is respectfully submitted that the teachings of *Perkowski* and *Want* would have provided insufficient guidance for a skilled artisan having these references before him/her to make the combination suggested by the Examiner. Applicant respectfully asserts that the Examiner's conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant's disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight. *In re Dembiczak*, 50

USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)).

Without a suggestion of the desirability of “the combination,” a combination of such references is made in hindsight, and the “range of sources available, however, does not diminish the requirement for actual evidence.” *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be “clear and particular.” *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

Because neither *Perkowski* nor *Want* teach or suggest systems that track individual instances of assets in a supply chain, Applicant respectfully submits that the asserted combination simply does not contemplate the proposed combination. This piecemeal selection of elements is tantamount to mixing teachings out of context. Such a rejection is not permissible under §103. See *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000) (proposed modification must not be made in the abstract but rather made in view of the entire teaching of the prior art).

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of prima facie obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

It is to be understood that the Applicants do not acquiesce to the Examiner’s characterization of the asserted art or the Applicants’ claimed subject matter, nor of the Examiner’s application of the asserted art or combinations thereof to the Applicants’ claimed subject matter. Moreover, the Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, alternative equivalent arrangements, common knowledge at the time of the Applicant’s invention, officially noticed facts, and the like. The Applicant respectfully submits that a detailed discussion of

each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching, suggestion or motivation to combine reference teachings.

The Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

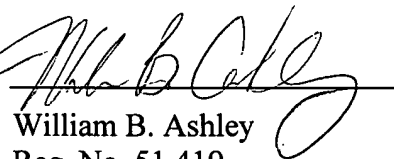
It is believed that pending claims 1, 2, 4-7, 10-32 and 34-40 are in condition for allowance and notification to that effect is respectfully requested. Authorization is given to charge Deposit Account No. 50-3581 (HONY.030PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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